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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,876	10/26/2001	Mark Duchow	670715-90029	1765

26710 7590 11/01/2004

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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/682,876

Applicant(s)

DUCHOW, MARK

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 76-93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 76-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/3/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Response to Amendment***

1. The amendment filed on August 25, 2004 is sufficient to overcome the rejection of Claims 67-75 in view of the Stewart et al. (6,259,405) and Scroggie et al. (6,185,541) references by canceling all rejected claims. The amendment also added new Claims 76-93 which have been considered in the Office Action below as the only remaining pending claims.

### ***Specification***

2. The amendment filed August 25, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the Applicant has attempted to narrow the original definition of "product" from including "both goods and services" to "goods and not services unless specified". This amendment, if entered, would change the scope of the invention from what was originally disclosed at the time of filing (See *Schering Corp. v. Amgen, Inc.*, 222 F.3d 1347, 1352-53, 55 USPQ2d 1650, 1654 (Fed. Cir. 2000)).

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

3. The amendment filed August 25, 2004 is sufficient to overcome the rejection of Claims 68 and 70-75 under 35 U.S.C. 112, first paragraph, in paragraph 5 of the June 1, 2004 Office Action by canceling these claims. Therefore, the Examiner hereby withdraws that rejection.

***Double Patenting***

4. The amendment filed on August 25, 2004 is sufficient to overcome the rejection of Claims 68, 69, 71, and 72 for double patenting under 35 U.S.C. 101 in paragraph 7 of the June 1, 2004 Office Action by canceling these claims. Therefore, the Examiner hereby withdraws that rejection.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 76-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al (6,259,405) in view of Scroggie et al (6,185,541).

Claim 76: Stewart discloses a method of distributing a voucher (discount/offer) to a prospective customer visiting a website on the Internet, comprising:

- a. providing screen displays to allow the customer to select a desired producer (airline)(col 24, lines 29-33);
- b. providing screen displays to allow the customer to enter product selection information (reservation information), personal ID data, and a postal code (col 20, lines 48-54 and 61-67);
- c. receiving the above data through the Internet (col 9, lines 35);
- d. generating a voucher (offer) redeemable only at a reseller selected by the system (col 27, lines 26-37);
- e. communicating the voucher data to the prospective customer and the selected reseller (col 25, lines 18-32); and
- f. selecting the one reseller based on the product selected and the postal address code (address) of the prospective customer (col 11, lines 21-31 and col 22, lines 22-31).

Stewart discloses the user (MU) entering the desired producer (such as an airline or hotel chain), product selection information (such as requesting a reservation for a rental car, airline flight, or hotel room), the user's personal ID data and the user's location data (such as an address or geographic location). The system will then select one reseller (local hotel) which can provide the desired product or service based on the user's location and/or demographic information. Once the reseller is selected, Stewart notifies both the user and the reseller. While it is not explicitly disclosed that the user's address includes the postal code, the Examiner notes that in this country the United State Postal Service has required a postal code (i.e. zip code) to be included in the

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address since the 1960's. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the postal code as part of the address in Stewart. One would have been motivated to include the postal code in order to store a complete address for the user. While Stewart discloses selecting the reseller based on the location of the user, it is not explicitly disclosed that the user's postal address code would be used to determine the user's location. However, Stewart discloses a plurality of methods for determining the user's location, such as wireless local area network access points (i.e. cellular telephone towers), sensors with known locations detecting the presence of the user's mobile unit (e.g. passing through an entrance at an airport), GPS systems, etc. Stewart further discusses the advantages and disadvantages of the various methods due to the sensitivity of the system for determining the user's location, such as LAN access points giving a general location, a GPS system giving the user location within a few feet, or a stationary wired access point giving the exact known location for the wired access point. Furthermore, Scroggie discloses a similar method of distributing a voucher (discount incentive) in which "the user is required to enter his or her ZIP code or other postal code, since many features of the system are location-dependent" (col 6, lines 56-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that if only the general location of the user was desired information such as the postal code, telephone area code, or Internet connection point could be used. One would have been motivated to use a general location indicator, such as a postal code, in order to provide a quick method of targeting general area advertisements or promotions, i.e. a

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promotional program aimed at a large area (city) instead of a specific location (shopping mall).

Claim 77: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. As discussed above, Stewart discloses that the system selects the local retailer (specific hotel) automatically once the customer has selected the producer and desired product (and location information). Thus, the customer's control over selection of the reseller is limited to entering such information (producer, product, and location).

Claim 78: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart further discloses transmitting a message to the customer after a car reservation is completed indicating the preparedness of the car and then adds that the price of the product may also be transmitted to the customer (col 21, lines 12-19). Thus, it is disclosed in the first instance that the message may be transmitted to the customer without the price also being transmitted (and displayed).

Claim 79: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart also discloses the customer entering the data and receiving the information during a single online session (col 22, lines 49-50). While Stewart also discloses that the system may use

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previously stored information about the customer's demographic and preference information, in some of the disclosed embodiments the customer enters this information during the session.

Claim 80: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart further discloses that the customer receives a single voucher (advertisement/discount/coupon) during the session (since only one product is being selected). Furthermore, it is a design decision by the system operator and/or the advertiser on determining how many vouchers to send to the customer during the session. The Examiner further notes that while a marketer could allow multiple coupons to be redeemed for a single item, it is usual and customary in the marketing arts to only allow one voucher (coupon/discount) to be applied to a purchase of a product. Therefore, it would have been obvious to only distribute one voucher for the one product selected by the customer in Stewart. One would have been motivated to only distribute a single voucher in order to prevent a customer from redeeming so many vouchers that the product is free; thus, defeating the purpose of the voucher. For example, if the system issues a \$1.00 discount voucher for a \$5.00 product and the customer redeems 5 of the voucher on a purchase of a single unit of the product, the customer would effectively pay nothing for the product (except possible sales taxes). If the customer redeemed 6 voucher for the same product, the reseller would not only have to give the product to the customer for free, but would also owe the customer an additional dollar.



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Claim 81: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart further discloses the system selecting a restaurant, rental car agency, or airline serving the user's location based on the stored preferences of the user and the user's location (col 20, line 47 – col 24, line 42). Additionally, Scroggie further discloses that the buyer may go to the manufacturer's offer page and select one or more product offers from a manufacturer (col 7, line 64- col 8, line 21). The system will then select and display one or more local retailers which sell that product. It is inherent that if the product is an exclusive product, i.e. one which is sold by only one retail chain, such as a franchise (e.g. Skilcraft Tools™ sold by Sears), that the system would display the local or closest Sears store. Likewise, if the user selected Kentucky Fried Chicken (KFC) as the manufacturer and fried chicken as the product, the system would select the KFC franchisee which had been assigned coverage of the geographic location of the user. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Stewart would select the reseller which had been assigned coverage of the geographic location of the user.

Claim 82: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart further discloses the system selecting the local retailer based on the customer's entry of a desired hotel chain or car rental company (i.e. producers) and the customer's location.

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While in some embodiments, Stewart also bases the selection on the customer's stored demographic information, this is not the case in all embodiments.

Claim 83: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart further discloses the voucher is a purchase price discount of the selected product (e.g. "Next 3 customers to purchase a Nintendo 64 entertainment system pay only \$29.99.")(col 26, lines 42-67).

Claim 84: Stewart and Scroggie disclose a method of distributing a voucher (discount/offer) to a prospective customer as in Claim 76 above. Stewart further discloses the personal information includes the email address of the customer (col 11, lines 21-31).

Claim 85: : Stewart discloses a method of distributing a voucher (discount/offer) to a prospective customer visiting a website on the Internet, comprising:

a. providing screen displays to allow the customer to select a desired producer (airline)(col 24, lines 29-33) and product selection information (reservation information)(col 20, lines 48-54 and 61-67);

b. providing screen displays to allow the customer to enter personal ID data, and a postal code (col 20, lines 48-54 and 61-67);

c. receiving the above data through the Internet (col 9, lines 35);

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d. selecting the one reseller based on the product selected and the postal address code (address) of the prospective customer (col 11, lines 21-31 and col 22, lines 22-31).

e. generating a time limited voucher (offer)(e.g. "For the next 15 minutes, all watches are 25% off at ABC Watch Company, which is located in the A concourse, between gates 14 and 16")(col 28, lines 36-40) redeemable only at a reseller selected by the system (col 27, lines 26-37); and

f. communicating the voucher data to the prospective customer and the selected reseller (col 25, lines 18-32).

Stewart discloses the user (MU) entering the desired producer (such as an airline or hotel chain), product selection information (such as requesting a reservation for a rental car, airline flight, or hotel room), the user's personal ID data and the user's location data (such as an address or geographic location). The system will then select one reseller (local hotel) which can provide the desired product or service based on the user's location and/or demographic information. Once the reseller is selected, Stewart notifies both the user and the reseller. While it is not explicitly disclosed that the user's address includes the postal code, the Examiner notes that in this country the United State Postal Service has required a postal code (i.e. zip code) to be included in the address since the 1960's. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the postal code as part of the address in Stewart. One would have been motivated to include the postal code in order to store a complete address for the user. While Stewart discloses selecting the reseller

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based on the location of the user, it is not explicitly disclosed that the user's postal address code would be used to determine the user's location. However, Stewart discloses a plurality of methods for determining the user's location, such as wireless local area network access points (i.e. cellular telephone towers), sensors with known locations detecting the presence of the user's mobile unit (e.g. passing through an entrance at an airport), GPS systems, etc. Stewart further discusses the advantages and disadvantages of the various methods due to the sensitivity of the system for determining the user's location, such as LAN access points giving a general location, a GPS system giving the user location within a few feet, or a stationary wired access point giving the exact known location for the wired access point. Furthermore, Scroggie discloses a similar method of distributing a voucher (discount incentive) in which "the user is required to enter his or her ZIP code or other postal code, since many features of the system are location-dependent" (col 6, lines 56-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that if only the general location of the user was desired information such as the postal code, telephone area code, or Internet connection point could be used. One would have been motivated to use a general location indicator, such as a postal code, in order to provide a quick method of targeting general area advertisements or promotions, i.e. a promotional program aimed at a large area (city) instead of a specific location (shopping mall).

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Claim 86: This claim includes the same features and limitations as Claim 77 above and is rejected as being obvious as discussed above.

Claim 87: This claim includes the same features and limitations as Claim 78 above and is rejected as being obvious as discussed above.

Claim 88: This claim includes the same features and limitations as Claim 79 above and is rejected as being obvious as discussed above.

Claim 89: This claim includes the same features and limitations as Claim 80 above and is rejected as being obvious as discussed above.

Claim 90: This claim includes the same features and limitations as Claim 81 above and is rejected as being obvious as discussed above.

Claim 91: This claim includes the same features and limitations as Claim 82 above and is rejected as being obvious as discussed above.

Claim 92: This claim includes the same features and limitations as Claim 83 above and is rejected as being obvious as discussed above.

Claim 93: This claim includes the same features and limitations as Claim 84 above and is rejected as being obvious as discussed above.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 67-75 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed August 25, 2004 have been fully considered but they are not persuasive. The specific issues raised pertaining to the disclosure of the two cited references have been incorporated into the rejection of the newly entered claims above.

a. The Applicant argues in reference to the new matter rejection in paragraph 3 of the June 1, 2004 office action that "Words added to the specification are not new matter where they are: 1) rephrasing of a passage, 2) an obvious error, 3) a description of a something that inherently functions in the manner described or 4) constitute an example though not described in the specification can be arrived at without undue experimentation. MPEP 2163, 2164." (pages 17-18). The Examiner notes that in this case, the modification of "and that are located closest to the buyer" to "and that has the territory that includes, or is located closest to, the buyer", is not merely rephrasing the original passage nor is it inherent from the original passage (neither is it an obvious error nor an example). The original wording limited the selection process to selecting whichever reseller was located closest to the buyer, with no inference of the reseller having an assigned territory. In other words, when two KFC franchises were nearby,

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the system would select the closest franchise. The modified language of the amendment limits the selection process to selecting the reseller who has the assigned territory, but who may or may not be the closest to the buyer. This is neither inherent nor obvious in the original wording of the specification.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

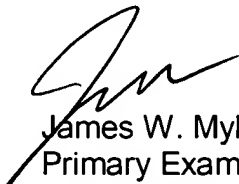
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM  
October 27, 2004



James W. Myhre  
Primary Examiner  
Art Unit 3622